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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,382	11/06/2000	J. T. Lin		6277

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EXAMINER

COHEN, LEE S

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/07/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,382

Applicant(s)

LIN, J. T.

Examiner

Lee S. Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20, 23, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 – “the corneal sclera tissue” in line 2 is vague, “said laser beam” in line 6 lacks antecedent basis, and “a said predetermined pattern” in lines 6-7 is vague, and “portion” in line 8 should be plural. Claim 4 – infrared laser should reference its prior recital. Claim 8 – “said laser beam” lacks antecedent basis. Claim 9 – “meter” should be plural in line 2. Claim 10 – “said laser beam” lacks antecedent basis. Claim 11 sets forth an improper Markush recitation. Claim 12 – “said laser beam” and “the treated area” lack antecedent basis. Claim 13 – “said laser beam” and “the treated area” lack antecedent basis. Claim 16 – “a predetermined patterns” is vague.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 8, 14-20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (5,520,679) in view of Schachar (5,489,299).

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The Lin reference discloses conventional apparatus for performing laser surgery on an eye. The various elements including a beam spot controller, scanner, and fiber delivery unit as well as the particular parameters relating to wavelength, spot size, and ablation depth are all shown by Lin. The reference can be employed to perform various corrective procedures on the eye but fails to disclose ablation of the sclera outside the limbus to correct presbyopia by expansion of the sclera.

Schachar discloses various treatment methods for presbyopia relating to expansion of the sclera. In particular, laser ablation of scleral tissue to accomplish such treatment is taught at column 7, lines 53-59 and column 8, lines 10-20.

Given the teaching of Schachar, it would have been obvious to the skilled artisan to employ the laser methodology of Lin on the sclera to correct presbyopia. As noted supra, the various parameters to accomplish the laser ablation are taught by Lin. Further, numerous patterns are disclosed by Lin. Claimed patterns not expressly shown by Lin would have been obvious design expedients to the skilled artisan to effect the procedure. In addition, the position of the conjunctiva during the procedure would have been within the level of skill of the artisan to select to optimize the procedure.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Schachar as applied to claim 1 above, and further in view of Rozoiu et al (5,741,247). The use of a XeCl laser having a wavelength of 308 nm. would have been obvious in the method since such a laser's use is conventional in the art as disclosed by Rozoiu et al.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Schachar as applied to claim 1 above, and further in view of Mathis et al (5,599,341). Fiber

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structure for delivering a laser beam is conventional in the art as disclosed by Mathis et al. Accordingly, the use of the same in the methodology would have been an obvious to the skilled artisan. The particular length of the fiber is deemed to be a mere design expedient absent criticality.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin in view of Schachar and Mathis et al as applied to claim 9 above, and further in view of Tsushima et al (5,845,024). The particular fiber structure for delivering a laser beam is conventional in the art as disclosed by Tsushima et al. Accordingly, the use of the same in the methodology would have been an obvious design expedient to the skilled artisan.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20, 23, and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-15 of U.S. Patent No. 6,258,082 and claims 1-13 of U.S. Patent No. 6,263,879. Although the conflicting claims are not identical, they are not patentably distinct from each other because they represent an obvious change in scope.

Response to Arguments

Applicant's arguments filed January 8, 2002 have been fully considered but they are not persuasive. As previously pointed out, Schachar discloses various treatment methods for presbyopia relating to expansion of the sclera and the use of laser ablation of scleral tissue to accomplish such treatment. Given this clear teaching, the use of the laser methodology of Lin on the sclera to correct presbyopia would certainly have been obvious to the skilled artisan. Arguments relating to Schachar per se are without merit. Further, Lin teaches the use of fiber delivery units to have been conventional in the art at column 4, line 20+ and column 10, line 39+. Responses to the other arguments are discussed in the rejection supra.

As to the double patenting rejections, the prior patents claim presbyopic treatment including a combination of scanning and fiber optic delivery. The claims of the current application claim the same general concept. Accordingly, the rejections are proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 703-308-2998. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Lee S. Cohen
Primary Examiner
Art Unit 3739

LSC
May 5, 2003